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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/543,143

07/22/2005

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EXAMINER

CANDLER, SAMUEL M

ART UNIT

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3739

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/543,143	Applicant(s) KIM ET AL.	
	Examiner SAMUEL CANDLER	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) 15-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 39-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/22/2005, 10/25/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 15-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/30/2008. Regarding the Applicant's arguments, the Applicant asserts on page 2, full paragraph 2 that the inventions of Group 1 and Group 2 are similar merely because they are species of a device having a sensor placed inside the body. However, there is a wide variety of sensors for being placed within the body that are found in the medical device field in a variety of different subclasses not limited to sensors for communication, temperature measurement, light measurement, pH measurement, and movement detection. Furthermore, it is not a requirement of the 371 restriction process to provide a listing of applicable subclasses to the inventions. Group 1 (Claims 1-14 and 39-42) will hereby be examined.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the 'isolator' must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

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number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because of the following informalities: Page 2 line 15 is a heading that states ‘Technical Gist of the Pesent Invention.’ This should be changed to ‘Summary of the Present Invention.’

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 11-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 11-12, the Applicant claims an 'isolator' made of one of peek, polyethylene, and polypropylene. However, on page 7 lines 11-17 of the specification, the Applicant states that the surface of the sensor is formed by these materials, and there is no mention of 'an isolator.'

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-2, 4-14 and 39-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Re claims 1-2, lines 4-5 of claim 1 cite 'transmitting electrodes;' however, lines 6 and 9 of claim 1 cite 'the transmitting electrode,' even though a designation for a particular transmitting electrode has not been established.

9. Re claims 4-10 and 13-14, lines 3-4 of claim 3 cite 'transmitting electrodes;' however, each of claims 4-10 and 13 cite 'the transmitting electrode,' even though a designation for a particular transmitting electrode has not been established.

10. Re claims 39-42, lines 4-5 of claim 39 cite 'transmitting electrodes;' however, lines 6 and 9 of claim 1 cite 'the transmitting electrode,' even though a designation for a particular transmitting electrode has not been established.

11. Claims 11-12 recite the limitation "the isolator" in line 1 of claim 11. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-6, 13 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Brockway et al (U.S. PGPub 2002/0138009).

14. Re claims 1-3, 13 and 39, Brockway et al discloses a sensor 400 (see paragraph [0055]; Figure 4) having first and second electrodes 405a-b (see paragraph [0055]; Figure 4) between which an electrical potential difference is generated (see paragraph [0023]) and from which a current flows through the human body to a receiver 410 (see paragraphs [0022] and [0055]; Figure 4) installed on the surface of the human body.

15. Re claim 5, Brockway et al discloses wherein the electrodes are transmitting information of a separate electrical medical device which would contain an internal circuit (see paragraph [0054]).

16. Re claims 4 and 6, Brockway et al discloses wherein the electrodes are insulated from each other (see paragraph [0053]).

17. Claims 1-3, 5, 13 and 39-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Gersheneld et al (U.S. Patent No. 5,914,701).

18. Re claims 1-3, 13 and 39, Gersheneld et al discloses a sensor having a pair of transmitting electrodes 18, 20 (see col. 2 lines 9-19 and col. 3 lines 46-48; Figure 1) between which an electrical potential difference is generated and from which a current

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flows through the human body to a receiver 22 (see col. 2 lines 25-39 and col. 3 lines 55-64; Figure 1) installed on the surface of the human body

19. Re claims 5 and 40, Gersheneld et al discloses an internal circuit 16 (see col. 4 lines 40-41; Figure 1) that is electrically connected to the transmitting electrodes and can vary the voltages between the two electrodes (see col. 2 lines 9-16).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brockway et al. Brockway does not explicitly disclose any structural location for the electrodes on the sensor device. However, Brockway et al does state that 'structural, logical, and electrical changes may be made without departing from the spirit and the scope of the present invention.' It is not shown that any disadvantage would be provided by simply reshaping or moving the electrodes and would therefore be obvious to place the electrodes of Brockway in different structural locations on the sensor device.

22. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brockway et al in view of Bashiri et al (U.S. Patent No. 6,165,178). Brockway et al discloses that the transmitting electrodes are insulated from each other on the sensor but fails to disclose the details of the materials of the insulating means. Bashiri et al

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teaches using polyethylene and parylene as electrically insulating materials (see col. 5 lines 35-40). Therefore, it would have been obvious to one of the skill in the art at the time of invention to 'fill in the gaps' of the device of Brockway et al with the details of the device of Bashiri et al.

23. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brockway et al in view of Yoshioka et al (U.S. Patent No. 5,651,869). Brockway et al discloses an electrode which would be made of a conductive material, but he fails to disclose the details regarding the materials of the electrode. Yoshioka et al discloses using gold as an electrical contact and that it is known in the art (see col. 4 lines 9-13). Therefore, it would have been obvious to one of the skill in the art at the time of invention to 'fill in the gaps' of the device of Brockway et al with the details of the device of Yoshioka et al.

24. Claims 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brockway et al in view of Holmes et al (U.S. Patent No. 4,267,415). Brockway et al discloses the communication circuit operating using a very low current conducted through the body to the remote receiver (see paragraph [0053]) but fails to disclose the details of how a low current is achieved. Holmes teaches a current limiting circuit that includes a resistor with a capacitor in parallel (see col. 3 lines 28-35; Figure 1). Therefore, it would have been obvious to one of the skill in the art at the time of invention to 'fill in the gaps' of the device of Brockway et al with the details of the device of Holmes et al.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references disclose devices that use the human body as a transmission medium:

U.S. Patent No. 6,771,161

U.S. Patent No. 6,223,018

U.S. Patent No. 6,104,913

U.S. Patent No. 6,409,674

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMUEL CANDLER whose telephone number is (571)270-3410. The examiner can normally be reached on Monday - Friday, 8 a.m. - 5 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. C./
Examiner, Art Unit 3739

/John P Leubecker/
Primary Examiner, AU 3739